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SPECIAL INSTRUCTIONS: S/N 09/556,285

Enclosed Please find a response to
your advisory action mailed on 9/24/03.

Thank you

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: G. Taylor

SERIAL NO.: 09/556,285

GROUP ART UNIT: 2811

FILED: April 24, 2000


EXAMINER: G. Munson

FOR: A III-V Charge Coupled
Device Suitable for Visible,
Near and Far Infra-red
Detection

ATT'Y DOCKET: OPE-002

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I hereby certify that this correspondence is being transmitted by facsimile on this day to 703-872-9306 to Commissioner for Patents, Alexandria, VA 22313	
	<u>Oct 15, 2003</u>
David P. Gordon Reg. No. 29,996	Date

OFFICIAL

Honorable Commissioner of Patents
and Trademarks
Washington, D.C. 20231

Sir:

RESPONSE

Applicant respectfully submits that the Advisory Action mailed on September 24, 2003 in the above-referenced application was mistakenly issued by the Patent Office. The issuance of the Advisory Action was improper because the Applicant filed a continuation application on August 18, 2003. Applicant respectfully asserts that this continuation application, which was filed under 37 CFR 1.53(d), should be automatically treated as a request for continued examination under 37 CFR 1.114 (see col. 3 of Fed. Reg., Vol. 65, No. 159, page 50093, attached hereto). Applicant has brought this issue to the attention of the Examiner in the above-captioned applicant (Examiner Gene Munson), but the

issue has yet to be resolved by docketing personnel in the Patent Office.

The continuation application filed by the Applicant on August 18, 2003 was responsive to all of the issues identified by the Examiner in the Final Office Action mailed April 17, 2003. Applicant respectfully requests prompt examination of the subject application.

No extension of time and no fees are believed to be due in conjunction with this paper; however, if any fee is due, please charge the fee to deposit account no. 07-1732.

In light of all of the above, it is submitted that the present application is in order for prompt examination. Should any issues remain outstanding, the Examiner is invited to call the undersigned attorney of record so that the case may proceed expeditiously to allowance.

Respectfully submitted,



David P. Gordon
Reg. #29,996
Attorney for Applicant(s)

65 Woods End Road
Stamford, CT 06905
(203) 329-1160
October 15, 2003

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DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

37 CFR Part 1

RIN 0851-AB13

Request for Continued Examination Practice and Changes to Provisional Application Practice

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Final rule.

SUMMARY: The United States Patent and Trademark Office (Office) is revising the rules of practice in patent cases to implement certain provisions of the American Inventors Protection Act of 1999. These provisions of the American Inventors Protection Act of 1999: Provide for continued examination of an application for a fee; extend the pendency of a provisional application if the date that is twelve months after the filing date of the provisional application falls on Saturday, Sunday, or a Federal holiday within the District of Columbia; eliminate the copendency requirement for a nonprovisional application to claim the benefit of a provisional application; provide for the conversion of a provisional application to a nonprovisional application; and provide a prior art exclusion for certain commonly assigned patents.

EFFECTIVE DATE: August 16, 2000.

FOR FURTHER INFORMATION CONTACT:

Robert W. Bahr, Karin L. Tyson, or Robert A. Clarke by telephone at (703) 308-6906, or by mail addressed to: Box Comments—Patents, Commissioner for Patents, Washington, DC 20231, or by facsimile to (703) 872-9411, marked to the attention of Robert W. Bahr.

SUPPLEMENTARY INFORMATION: The American Inventors Protection Act of 1999 (Title IV of the Intellectual Property and Communications Omnibus Reform Act of 1999 (S. 1948) as introduced in the 106th Congress on November 17, 1999) was incorporated and enacted into law on November 29, 1999, by § 1000(a)(9), Division B, of Pub. L. 106-113, 113 Stat. 1501 (1999). The American Inventors Protection Act of 1999 contains a number of changes to title 35, United States Code. The United States Patent and Trademark Office (Office) published an interim rule revising the rules of practice to implement the provisions of §§ 4403, 4801, and 4807 of the American Inventors Protection Act of 1999. See *Changes to Application Examination and Provisional Application Practice*,

Interim Rule, 65 FR 14865 (Mar. 20, 2000), 1233 Off. Gaz. Pat. Office 47 (Apr. 11, 2000). This notice adopts final changes to the rules of practice to implement these provisions of the American Inventors Protection Act of 1999.

Section 4403 of the American Inventors Protection Act of 1999 is effective on the date six months after the date of enactment of the American Inventors Protection Act of 1999 (May 29, 2000) and applies to applications (other than for a design patent) filed on or after June 8, 1995. Section 4801 of the American Inventors Protection Act of 1999 is effective on the date of enactment of the American Inventors Protection Act of 1999 (November 29, 1999) and applies to all provisional applications (with limited exception) filed on or after June 8, 1995. Section 4807 of the American Inventors Protection Act of 1999 is effective on the date of enactment of the American Inventors Protection Act of 1999 (November 29, 1999) and applies to all applications filed on or after November 29, 1999.

Section 4403 (Continued Examination of Patent Applications): Section 4403 of the American Inventors Protection Act of 1999 amends 35 U.S.C. 132 to state that the Office "shall prescribe regulations to provide for the continued examination of applications for patent at the request of the applicant," and that the Office "may establish appropriate fees for such continued examinations and shall provide a 50 percent reduction in such fees for small entities that qualify for reduced fees under [35 U.S.C. 41(h)(1)]." Previously, an applicant had to file a continuing application (a continuing application under § 1.53(b) or a continued prosecution application under § 1.53(d)) to obtain continued examination of an application for a fee (the application filing fee). Section 4403 of the American Inventors Protection Act of 1999 will provide statutory authority for the continued examination of an application for a fee (to which the small entity reduction will be applicable) without requiring the applicant to file a continuing application.

Section 4801 (Provisional Applications): Section 4801(a) of the American Inventors Protection Act of 1999 amends 35 U.S.C. 111(b)(5) to provide that "[n]otwithstanding the absence of a claim, upon timely request and as prescribed by the Director, a provisional application may be treated as an application filed under [35 U.S.C. 111(a)]" but that if "no such request is made, the provisional application shall be regarded as abandoned 12 months

after the filing date of such application and shall not be subject to revival * * *." Thus, § 1.53(c) is amended to provide both for the conversion of a provisional application (35 U.S.C. 111(b) and § 1.53(c)) to a nonprovisional application (35 U.S.C. 111(a) and § 1.53(b)), and for the conversion of a nonprovisional application (35 U.S.C. 111(a) and § 1.53(b)) to a provisional application (35 U.S.C. 111(b) and § 1.53(c)).

Section 4801 of the American Inventors Protection Act of 1999 contains no provision for according the resulting nonprovisional application a filing date other than the original filing date of the provisional application. Thus, under the patent term provisions of 35 U.S.C. 154, the term of a nonprovisional application resulting from the conversion of a provisional application pursuant to 35 U.S.C. 111(b)(5) will be measured from the original filing date of the provisional application (which is the filing date accorded the nonprovisional application resulting from conversion under § 4801 of the American Inventors Protection Act of 1999). Applicants are strongly cautioned to consider the patent term implications of converting a provisional application into a nonprovisional application pursuant to 35 U.S.C. 111(b)(5), rather than simply filing a nonprovisional application within twelve months of the provisional application's filing date and claiming the benefit of the provisional application under 35 U.S.C. 119(e).

Section 4801(b) of the American Inventors Protection Act of 1999 also amends 35 U.S.C. 119(e) to provide that "[i]f the day that is 12 months after the filing date of a provisional application falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, the period of pendency of the provisional application shall be extended to the next succeeding secular or business day."

Section 4801(c) of the American Inventors Protection Act of 1999 also amends 35 U.S.C. 119(e) to eliminate the requirement that a provisional application be pending on the filing date of the nonprovisional application for the nonprovisional application to claim the benefit of the provisional application.

Section 4807 (Prior Art Exclusion): 35 U.S.C. 103 was amended in 1984 to exclude subject matter developed by another person which qualifies as prior art only under 35 U.S.C. 102(f) or (g) as prior art under 35 U.S.C. 103 against a claimed invention, provided that the subject matter and the claimed invention were commonly owned by the

same person or organization or subject to an obligation of assignment to the same person or organization at the time the claimed invention was made. See Pub. L. 98-622, § 103, 98 Stat. 3384 (1984). Section 4807 of the American Inventors Protection Act of 1999 amends 35 U.S.C. 103(c) to exclude subject matter developed by another person which qualifies as prior art only under one or more of 35 U.S.C. 102(e), (f), or (g) as prior art under 35 U.S.C. 103 against a claimed invention, provided that the subject matter and the claimed invention were commonly owned by the same person or organization or subject to an obligation of assignment to the same person or organization at the time the claimed invention was made. The Office has published guidelines concerning the implementation of this change to 35 U.S.C. 103(c). See *Guidelines Concerning the Implementation of Changes to 35 U.S.C. 102(g) and 103(c) and the Interpretation of the Term "Original Application" in the American Inventors Protection Act of 1999*, 1233 Off. Gaz. Pat. Office 54 (Apr. 11, 2000).

Discussion of Specific Rules: The Office is adopting the changes set forth in the Interim Rule to §§ 1.7, 1.17(e) and (i), 1.53(d)(1), 1.78(a)(3), 1.87(b), 1.104(c)(4), 1.113, 1.116, 1.198, 1.312, and 1.313(a), (b), (c)(1), (c)(3), and (d) in this final rule. The Office is adopting revised §§ 1.53(c)(3), 1.103, 1.114, and 1.313(a) and (c)(2) in this final rule.

Title 37 of the Code of Federal Regulations, Part 1, is amended as follows:

Section 1.7 is amended by designating the current text as paragraph (a) and adding a new paragraph (b) to provide that if the day that is twelve months after the filing date of a provisional application under 35 U.S.C. 111(b) and § 1.53(c) falls on Saturday, Sunday, or a Federal holiday within the District of Columbia, the period of pendency shall be extended to the next succeeding secular or business day which is not a Saturday, Sunday, or a Federal holiday.

Section 1.17(e) sets forth the fee to request continued examination pursuant to new § 1.114, which is set at an amount equal to the basic filing fee for a utility application. Therefore, the fee for considering a submission pursuant to § 1.114 is currently \$690.00 (\$345.00 for a small entity).

Section 1.17(i) is amended to include a reference to the fee to convert a provisional application filed under § 1.53(c) to a nonprovisional application under § 1.53(b), and to eliminate the reference to § 1.312.

Section 1.53 is amended by redesignating paragraph (c)(3) as

paragraph (c)(4) and adding a new paragraph (c)(3) to provide for the conversion of a provisional application to a nonprovisional application. Section 1.53(c)(3) provides that a request to convert a provisional application filed under § 1.53(c) to a nonprovisional application under § 1.53(b) must be accompanied by the fee set forth in § 1.17(i) and an amendment including at least one claim as prescribed by the second paragraph of 35 U.S.C. 112, unless the provisional application otherwise contains at least one claim. Section 1.53(c)(3) also provides that such a request must be filed prior to the earliest of: (1) abandonment of the provisional application; or (2) expiration of twelve months after the filing date of the provisional application.

Section 1.53(c)(3) also provides that the nonprovisional application resulting from conversion of a provisional application must also include the filing fee for a nonprovisional application, an oath or declaration by the applicant pursuant to §§ 1.63, 1.162, or 1.175, and the surcharge required by § 1.16(e) if either the basic filing fee for a nonprovisional application or the oath or declaration was not present on the filing date accorded the resulting nonprovisional application. While this language was not included in interim § 1.53(c)(3), it simply clarifies that once a provisional application is converted into a nonprovisional application, the resulting nonprovisional application must comply with the requirements applicable to nonprovisional applications (e.g., the requirement for the basic filing fee for a nonprovisional application and an oath or declaration by the applicant pursuant to §§ 1.63, 1.162, or 1.175).

Section 1.53(c)(3) also provides that the conversion of a provisional application to a nonprovisional application will not result in either the refund of any fee properly paid in the provisional application or the application of any such fee to the filing fee, or any other fee, for the nonprovisional application.

Finally, § 1.53(c)(3) contains the admonitions that: (1) conversion of a provisional application to a nonprovisional application under § 1.53(c)(3) will result in the term of any patent to issue from the application being measured from at least the filing date of the provisional application for which conversion is requested; and (2) applicants should consider avoiding this adverse patent term impact by filing a nonprovisional application claiming the benefit of the provisional application under 35 U.S.C. 119(e)

(rather than converting the provisional application into a nonprovisional application pursuant to § 1.53(c)(3)).

The conversion of a provisional application to a nonprovisional application will not result in any savings in filing fees over the filing of a nonprovisional application claiming the benefit under 35 U.S.C. 119(e) and § 1.78 of the earlier provisional application. Thus, an applicant may simply file a nonprovisional application claiming the benefit under 35 U.S.C. 119(e) and § 1.78 of the earlier provisional application and avoid the fee set forth in § 1.17(i) required to convert a provisional application to a nonprovisional application (as well as the adverse patent term effects discussed above).

Section 1.53(d)(1)(i) is amended to provide that continued prosecution application (CPA) practice under § 1.53(d) does not apply to applications (other than design) if the prior application has a filing date on or after May 29, 2000. Thus, an application (except for a design application) must have an actual filing date before May 29, 2000, for the applicant to be able to file a CPA of that application. While the Office uses the filing date (and application number) of the prior application of a CPA for identification purposes, the filing date of a CPA under § 1.53(d) is the date the request for a CPA is filed. See § 1.53(d)(2). Thus, if a CPA of an application (other than for a design patent) is filed on or after May 29, 2000, § 1.53(d)(1)(i) does not permit the filing of a further CPA, regardless of the filing date of the prior application as to the first CPA (i.e., the filing date used for identification purposes for the CPA).

In the event that an applicant files a request for a CPA of a utility or plant application that was filed on or after May 29, 2000 (to which CPA practice no longer applies), the Office will automatically treat the improper CPA as a request for continued examination of the prior application (identified in the request for CPA) under new § 1.114 (unless the application has issued as a patent). If an applicant files a request for a CPA of an application to which CPA practice no longer applies and does not want the request for a CPA to be treated as a request for continued examination under § 1.114 (e.g., the CPA is a divisional CPA), the applicant may file a petition under § 1.53(e) requesting that the improper CPA be converted to an application under § 1.53(b). The requirements for such a petition under § 1.53(e) are identical to those set forth in section 201.06(b) of the *Manual of Patent Examining Procedure* (7th ed. 1998) (Rev. 1, Feb. 2000) (MPEP) for

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converting an improper file wrapper continuing (FWC) application under former § 1.62 to an application under § 1.53(b). The Office will not grant such a petition unless it is before the appropriate deciding official before an Office action has been mailed in response to the request for continued examination under § 1.114 (as the improper CPA is being treated). If an Office action has been mailed in response to the request for continued examination under § 1.114, the applicant should simply file an application under § 1.53(b) within the period for reply to such Office action.

If, however, an applicant files a transmittal paper that is ambiguous as to whether it is a continued prosecution application under § 1.53(d) or a request for continued examination under § 1.114 (e.g., contains references to both an RCE and a CPA), and the application is eligible for either a continued prosecution application under § 1.53(d) or a request for continued examination under § 1.114 (i.e., a plant or utility application filed on or after June 8, 1995, but before May 29, 2000), that ambiguity will be resolved in favor of treating the transmittal papers as a request for a CPA under § 1.53(d). Other papers filed with the transmittal paper (e.g., a preliminary amendment or information disclosure statement) will not be taken into account in determining whether a transmittal paper is a continued prosecution application under § 1.53(d), or a request for continued examination under § 1.114, or ambiguous as to whether it is a continued prosecution application under § 1.53(d) or a request for continued examination under § 1.114.

Section 1.53(d)(1)(ii)(A) is amended to refer to "§ 1.313(c)" rather than "§ 1.313(b)(5)" for consistency with the change to § 1.313.

Section 1.78 is amended to eliminate the requirement that a nonprovisional application be "copending" with a provisional application for the nonprovisional application to claim the benefit under 35 U.S.C. 119(e) of a provisional application. Section 1.78 is also amended to require that, for a nonprovisional application to claim the benefit of a provisional application, the provisional application must be entitled to a filing date as set forth in § 1.53(c), and have paid the basic filing fee set forth in § 1.16(k) within the time period set forth in § 1.53(g), and have any required English language translation filed within the time period set under § 1.52(d).

Section 1.97(b) is amended to indicate that an information disclosure statement will also be considered if it is filed

before the mailing of a first Office action after the filing of a request for continued examination under § 1.114.

Section 1.103 is amended to provide for a limited suspension of action after a request for continued examination under § 1.114. Section 1.103 is also amended based upon previously proposed changes to that section. See *Changes to Implement the Patent Business Goals*, Notice of Proposed Rulemaking, 64 FR 53772, 53799-00, 53833-34, (Oct. 4, 1999), 1228 *Off. Gaz. Pat. Office* 15, 39-40, 72 (Nov. 2, 1999) (Patent Business Goals Notice of Proposed Rulemaking). These changes are being adopted in this final rule because of the overlap between the provisions for a limited suspension of action after a request for continued examination under § 1.114 and the previously proposed limited suspension of action in a CPA under § 1.53(d).

The heading of § 1.103 is amended to add the phrase "by the Office" to clarify that § 1.103 applies only to suspension of action by the Office (by applicant request or at the initiative of the Office) and does not apply to a suspension of action (or reply) by the applicant.

Section 1.103(a) provides for suspension of action for cause. Specifically, § 1.103(a) provides that on request of the applicant, the Office may grant a suspension of action by the Office under this paragraph for good and sufficient cause. Section 1.103(a) also provides that: (1) The Office will not suspend action if reply by applicant to an Office action is outstanding; and (2) any petition for suspension of action under § 1.103(a) must specify a period of suspension not exceeding six months. Section 1.103(a) specifically provides that any petition for suspension of action under § 1.103(a) must also include: (1) A showing of good and sufficient cause for suspension of action; and (2) the fee set forth in § 1.17(h), unless such cause is the fault of the Office.

Section 1.103(b) provides for a limited suspension of action in a CPA filed under § 1.53(d). Section 1.103(b) specifically provides that on request of the applicant, the Office may grant a suspension of action by the Office under § 1.103(b) in a CPA for a period not exceeding three months. Section 1.103(b) also provides that any request for suspension of action under § 1.103(b) must be filed with the request for a CPA and include the processing fee set forth in § 1.17(i).

Section 1.103(c) provides for a limited suspension of action after a request for continued examination under § 1.114. Section 1.103(c) specifically provides that on request of the applicant, the

Office may grant a suspension of action by the Office under § 1.103(c) after the filing of a request for continued examination in compliance with § 1.114 for a period not exceeding three months. Since § 1.103(c) requires a request for continued examination in "compliance with § 1.114," a request for suspension of action under § 1.103(c) does not substitute for the submission (or fee) required by § 1.114. The period of suspension, however, may be used to prepare and file a supplement (e.g., affidavit or declaration containing test data) to the previously filed submission. Section 1.103(c) also provides that any request for suspension of action under § 1.103 must be filed with the request for continued examination under § 1.114, specify the period of suspension, and include the processing fee set forth in § 1.17(i). The ability to submit a request for suspension when a request for continued examination under § 1.114 is filed is particularly useful in that its fee (unlike the CPA filing fee) must be paid when the request for continued examination under § 1.114 is filed.

Section 1.103(d) provides that the Office will notify applicant if the Office, on its own initiative, suspends action on an application.

Section 1.103(e) provides for suspension of action for public safety or defense. Section 1.103(e) specifically provides that the Office may suspend action by the Office by order of the Commissioner if the following conditions are met: (1) The application is owned by the United States; (2) publication of the invention may be detrimental to the public safety or defense; and (3) the appropriate department or agency requests such suspension.

Section 1.103(f) provides that the Office will suspend action by the Office for the entire pendency of an application if the Office has accepted a request to publish a statutory invention registration in the application, except for purposes relating to patent interference proceedings under Subpart E.

Section 1.104(c)(4) is revised to replace "35 U.S.C. 102(f) or (g)" with "35 U.S.C. 102(e), (f) or (g)" for consistency with 35 U.S.C. 103(c) as amended by § 4807 of the American Inventors Protection Act of 1999.

Section 1.113 is amended to take into account that an applicant's after final reply options include filing a request for continued examination under § 1.114. Section 1.113 is also amended to locate the last two sentences of paragraph (a) in a new paragraph (c).

Section 1.114 is added to implement § 4403 of the American Inventors Protection Act of 1999. The Office is providing a procedure under which an applicant may obtain continued examination of an application in which prosecution is closed (e.g., the application is under a final rejection or a notice of allowance) by filing a submission and paying a specified fee. If a subsequent rejection or action is made final (or if the application is subsequently allowed), the applicant may again obtain continued examination of an application (consideration of a submission) upon the filing of a submission and an additional payment of the specified fee prior to abandonment of the application.

Since the relevant portion of § 4405(b)(1) of the American Inventors Protection Act of 1999 (the effective date provision for 35 U.S.C. 132(b)) states that continued examination provisions of 35 U.S.C. 132(b) apply to "all applications" filed under 35 U.S.C. 111(a) on or after June 8, 1995, the continued examination provisions of 35 U.S.C. 132(b) and § 1.114 apply to any nonprovisional (35 U.S.C. 111(a)) application filed on or after June 8, 1995, regardless of whether the application is a reissue application or a non-reissue (original) application. The continued examination provisions of 35 U.S.C. 132(b) and § 1.114, however, will not be available for: (1) A provisional application (which is not examined under 35 U.S.C. chapter 12); (2) an application for a utility or plant patent (whether reissue or non-reissue) filed under 35 U.S.C. 111(a) before June 8, 1995; (3) an international application filed under 35 U.S.C. 363 before June 8, 1995; (4) an application for a design patent; or (5) a patent under reexamination.

Under this procedure, the filing of a request for continued examination after the filing of a Notice of Appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal, will be considered a request to withdraw the appeal and to reopen prosecution of the application before the examiner. The filing of a request for continued examination (accompanied by the fee and a submission) after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the U.S. Court of Appeals for the Federal Circuit (Federal Circuit) or the commencement of a civil action, will also result in the finality of the rejection or action being withdrawn and the submission being considered.

In addition to the *res judicata* effect of a Board of Patent Appeals and

Interferences decision in an application (see MPEP 706.03(w)), a Board of Patent Appeals and Interferences decision in an application is the "law of the case," and is thus controlling in that application and any subsequent related application. See MPEP 1214.01 (where a new ground of rejection is entered by the Board of Patent Appeals and Interferences pursuant to § 1.196(b), argument without either amendment of the claims so rejected or the submission of a showing of facts can only result in a final rejection of the claims, since the examiner is without authority to allow the claims unless amended or unless the rejection is overcome by a showing of facts not before the Board of Patent Appeals and Interferences). As such, a submission containing arguments without either amendment of the rejected claims or the submission of a showing of facts will not be effective to remove such rejection.

The procedure set forth in § 1.114 will not be available in an application after the filing of a Notice of Appeal to the Federal Circuit or the commencement of a civil action, unless the appeal or civil action is terminated and the application is still pending. Unless an application contains allowed claims (or the court's mandate clearly indicates that further action is to be taken in the Office), the termination of an unsuccessful court appeal or civil action results in the abandonment of the application. See MPEP 1216.01.

If the application is under final rejection, the fee for a request for continued examination acts only to withdraw the finality of an Office action. If reply to an Office action is outstanding, a submission meeting the reply requirements of § 1.111 must be timely received to continue prosecution of an application. Put simply, the mere payment of the fee for a request for continued examination will not operate to toll the running of any time period set in the previous Office action for reply to avoid abandonment of the application. Likewise, filing a request for continued examination (with the fee and a submission) in an allowed application after the issue fee has been paid without a petition under § 1.313 to withdraw the application from issue will not operate to avoid issuance of the application as a patent. Nevertheless, if a request for continued examination (with the fee and a submission) is filed in an allowed application prior to payment of the issue fee, a petition under § 1.313 to withdraw the application from issue is not required.

To avoid confusion as to whether an applicant desires to amend the application prior to receiving continued

examination of the application, an appeal brief under § 1.192 or a reply brief under § 1.193(b), or related submissions, are expressly excluded as a submission for the purposes of § 1.114. The submission, however, may consist of the arguments in a previously filed appeal brief or reply brief submitted as a reply to the final rejection, or may simply consist of a submission that incorporates by reference the arguments in a previously filed appeal brief or reply brief.

35 U.S.C. 132(a) provides that "[n]o amendment shall introduce new matter into the disclosure of the invention." Any amendment entered pursuant to § 1.114 that is determined to contain new matter will be treated in the same manner that a reply under § 1.111 that is determined to contain new matter is currently treated. In those instances in which an applicant seeks to add new matter to the disclosure of an application, the procedure in § 1.114 is not available, and the applicant must file a continuation-in-part application under § 1.53(b) containing such new matter. In addition, as 35 U.S.C. 132(b) and § 1.114 provide continued examination of an application (and not examination of a continuing application), the Office will not permit an applicant to obtain continued examination on the basis of claims that are independent and distinct from the claims previously claimed and examined (see § 1.145).

The request for continued examination procedure in § 1.114 should not be confused with the transitional procedure for the further limited examination of patent applications set forth in § 1.129(a) (see *Changes to Implement 20-Year Patent Term and Provisional Applications*, Final Rule Notice, 60 FR 20195 (April 25, 1995), 1174 *Off. Gaz. Pat. Office* 15 (May 2, 1995)) or the CPA procedure set forth in § 1.53(d) (see *Changes to Patent Practice and Procedure*, Final Rule Notice, 62 FR 53131 (October 10, 1997), 1203 *Off. Gaz. Pat. Office* 63 (October 21, 1997)).

Comparison of the request for continued examination procedure in § 1.114 with the transitional procedure for the further limited examination of patent application set forth in § 1.129(a): The procedure set forth in this notice does not apply to any application that was filed prior to June 8, 1995. The transitional procedure set forth in § 1.129(a) applies only to applications, other than for a reissue or design patent, that have been pending for at least two years as of June 8, 1995, taking into account any references in such applications to any earlier filed

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application under 35 U.S.C. 120, 121, or 365(c), and is not applicable to any application filed after June 8, 1995. Therefore, an application eligible for the transitional procedure set forth in § 1.129(a) (unless filed on June 8, 1995), or any application filed before June 8, 1995, is not eligible for the procedure for continued examination set forth in this notice.

In addition, an applicant in an application eligible for the procedure for continued examination set forth in this notice is not limited in the number of times the fee for continued examination may be submitted. An applicant in an application eligible for the transitional procedure set forth in § 1.129(a), however, is limited to two opportunities to pay the fee for further examination of the application.

Moreover, under the transitional procedure set forth in § 1.129(a), a submission after final rejection or action will be considered if the submission and the requisite fee are filed prior to abandonment of the application and prior to the filing of an appeal brief. Under the request for continued examination procedure set forth in this notice, a submission will be considered if the submission and the requisite fee is filed prior to abandonment of the application. That is, under the request for continued examination procedure, a submission (and requisite fee) need not be filed prior to the filing of an appeal brief. In addition, under the request for continued examination procedure, a submission will be considered in an allowed application if the submission and the requisite fee are filed prior to payment of the issue fee (or later if a petition under § 1.313(c) to withdraw the application from issue is granted).

Comparison of the request for continued examination procedure in § 1.114 with the CPA procedure set forth in § 1.53(d): Section 1.53(d) is amended to make CPA practice inapplicable to applications (other than for a design patent) filed under 35 U.S.C. 111(a) on or after May 29, 2000, or resulting from international applications filed under 35 U.S.C. 363 on or after May 29, 2000. Continued prosecution application (CPA) practice was adopted to permit applicants to obtain continued examination of an application (for a fee) via the filing of a continuing application. 35 U.S.C. 132(b), however, provides statutory authority for the Office to prescribe regulations to permit applicants to obtain continued examination of an application (for a fee) without the need for a continuing application. The Office is not completely abolishing CPA practice in favor of the request for continued

examination practice in § 1.114 because the request for continued examination practice in § 1.114 is not applicable to applications filed before June 8, 1995 (or design applications), and the patent term adjustment provisions of Pub. L. 106-113 do not apply to applications filed before May 29, 2000. The Office, however, is restricting CPA practice to utility and plant applications filed before May 29, 2000, and design applications because maintaining two practices (as to applications eligible for the continued examination procedure of § 1.114) designed for the same purpose (obtaining continued examination of an application) is unnecessary and will result in confusion.

Since the request for continued examination practice in § 1.114 is applicable to utility and plant applications filed on or after June 8, 1995, and CPA practice in § 1.53(d) is applicable to utility and plant applications filed before May 29, 2000, and design applications, an applicant in a utility or plant application filed on or after June 8, 1995, but before May 29, 2000, may obtain further examination either by filing a request for continued examination under § 1.114 or by filing a CPA under § 1.53(d). Since the patent term adjustment provisions of Pub. L. 106-113 do not apply to applications filed before May 29, 2000, and a request for continued examination practice under § 1.114 (unlike a CPA under § 1.53(d)) is not the filing of a new application, whether further examination of such an application is sought by a request for continued examination under § 1.114 or a CPA under § 1.53(d) has an impact on whether any resulting patent is entitled to the patent term adjustment provisions of Pub. L. 106-113. Specifically, if an applicant in a utility or plant application filed before May 29, 2000, files a CPA under § 1.53(d) after May 29, 2000, the application being prosecuted (now a CPA) is an application filed on or after May 29, 2000, and is entitled to the patent term adjustment provisions of Pub. L. 106-113. If, however, an applicant in a utility or plant application filed before May 29, 2000 (but on or after June 8, 1995) files a request for continued examination under § 1.114, the application being prosecuted is not an application filed on or after May 29, 2000, and is not entitled to the patent term adjustment provisions of Pub. L. 106-113.

In addition, there are a number of additional differences between request for continued examination procedure set forth in this notice with the CPA procedure set forth in § 1.53(d) resulting from the fact that a CPA is the filing of

a new application, whereas continued examination under § 1.114 merely continues the examination of the same application: (1) A request for continued examination under § 1.114 is not permitted unless prosecution in the application is closed (cf. § 1.53(d)(1)); (2) the fee for continued examination under § 1.114 (§ 1.17(e)) does not have an additional claims fee component (cf. 1.53(d)(3)(ii)); (3) the fee for continued examination under § 1.114 may not be deferred (cf. § 1.53(f)); (4) a request for continued examination under § 1.114 is entitled to the benefit of a certificate of mailing under § 1.8 (cf. 1.8(a)(2)(i)(A)); (5) an applicant may not obtain examination of a different or non-elected invention (e.g., a divisional) in a request for continued examination under § 1.114; and (6) any change of inventors must be via the procedure set forth in § 1.48 (cf. 1.53(d)(4)).

Discussion of the specific provisions of new § 1.114: Section 1.114 is added to provide for continued examination of an application under 35 U.S.C. 132(b).

Section 1.114(a) provides that if prosecution in an application is closed, an applicant may obtain continued examination of an application by filing a submission and the fee set forth in § 1.17(e) prior to the earliest of: (1) Payment of the issue fee, unless a petition under § 1.313 is granted; (2) abandonment of the application; or (3) the filing of a notice of appeal to the U.S. Court of Appeals for the Federal Circuit under 35 U.S.C. 141, or the commencement of a civil action under 35 U.S.C. 145 or 146, unless the appeal or civil action is terminated. The action immediately subsequent to the filing of a submission and fee under § 1.114 may be made final only if the conditions set forth in MPEP 706.07(b) for making a first action final in a continuing application are met.

Interim § 1.114 did not require that prosecution in an application be closed for an applicant to obtain continued examination under that section, but only that the Office had mailed at least one of an Office action under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151. There is, however, no benefit (from applicant's perspective) to requesting continued examination under § 1.114 if prosecution in the application is not closed. Thus, any request for continued examination under § 1.114 in an application in which prosecution is not closed would probably have been filed in error. In addition, the legislative history of 35 U.S.C. 132(b) reveals that its continued examination provisions were designed for applications in which prosecution was closed. See 145 Cong. Rec. S.14708,

S. 14718 (daily ed. November 17, 1999) (statement of Sen. Lott); *see also* H.R. Rep. No. 106-464 at 128 (1999). Therefore, the Office considers it inappropriate to permit (or encourage) applicants to request and pay the fee for continued examination under 35 U.S.C. 132(b) and § 1.114 unless prosecution in the application is closed.

Section 1.114(b) provides that prosecution in an application is closed as used in § 1.114 means that the application is under appeal, or that the last Office action is a final action (§ 1.113), a notice of allowance (§ 1.311), or an action that otherwise closes prosecution in the application (*e.g.*, an Office action under *Ex parte Quayle*, 1935 Comm'r Dec. 11 (1935)).

Section 1.114(c) provides that a submission as used in § 1.114 includes, but is not limited to, an information disclosure statement, an amendment to the written description, claims, or drawings, new arguments, or new evidence in support of patentability. This definition in § 1.114 for "submission" is taken from § 1.129(a). Section 1.114(c) also provides that if reply to an Office action under 35 U.S.C. 132 is outstanding, the submission must meet the reply requirements of § 1.111. This provision will permit applicants to file a submission under § 1.114 containing only an information disclosure statement (§§ 1.97 and 1.98) in an application subject to a notice of allowance under 35 U.S.C. 151.

Section 1.114(d) provides that if an applicant timely files the fee set forth in § 1.17(e) and a submission, the Office will withdraw the finality of any Office action to which a reply is outstanding and the submission will be entered and considered. The phrase "withdraw the finality of any Office action" includes the withdrawal of the finality of a final rejection, as well as the withdrawal of the closing of prosecution by an Office action under *Ex parte Quayle*, 1935 Comm'r Dec. 11 (1935), or notice of allowance under 35 U.S.C. 151 (or notice of allowability). Section 1.114(d) also provides that if an applicant files a request for continued examination under § 1.114 after appeal, but prior to a decision on the appeal, it will be treated as a request to withdraw the appeal and to reopen prosecution of the application before the examiner. Thus, the filing of a request for continued examination under § 1.114 in an application containing an appeal awaiting decision after appeal will be treated as a withdrawal of the appeal by the applicant, regardless of whether the request for continued examination under § 1.114 includes the appropriate fee (§ 1.17(e)) or a submission

(§ 1.114(c)). Applicants should advise the Board of Patent Appeals and Interferences when a request for continued examination under § 1.114 is filed in an application containing an appeal awaiting decision. Otherwise, the Board of Patent Appeals and Interferences may refuse to vacate a decision rendered after the filing (but before recognition by the Office) of a request for continued examination under § 1.114. Section 1.114(d) also provides that an appeal brief or a reply brief (or related papers) will not be considered a submission under § 1.114 (discussed above).

Section 1.114(e) provides that the request for continued examination provisions of § 1.114 do not apply to: (1) A provisional application; (2) an application for a utility or plant patent filed under 35 U.S.C. 111(a) before June 8, 1995; (3) an international application filed under 35 U.S.C. 363 before June 8, 1995; (4) an application for a design patent; or (5) a patent under reexamination.

Section 1.116 is amended to add a paragraph (a) that takes into account that an applicant's after final amendment options include filing a request for continued examination under § 1.114, and to redesignate existing paragraphs (a), (b), and (c) as paragraphs (b), (c), and (d), respectively.

Section 1.198 is amended to take into account that an application in which an appeal has been decided by the Board of Patent Appeals and Interferences may also be reopened under the request for continued examination provisions of § 1.114.

Section 1.312 is amended by clarifying that an amendment under § 1.312 (after allowance) must be filed prior to or with payment of the issue fee.

Section 1.313(a) is being amended to provide that it is not necessary to file a petition to withdraw an application from issue if a request for continued examination under § 1.114 is filed prior to payment of the issue fee. If an applicant files a request for continued examination under § 1.114 (with the fee and a submission) prior to the date the issue fee is due, the applicant need not pay the issue fee to avoid abandonment of the application. Applicants are cautioned against filing a request for continued examination under § 1.114 prior to payment of the issue fee and subsequently paying the issue fee (before the Office acts on the request for continued examination under § 1.114) because doing so may result in issuance of a patent without consideration of the request for continued examination under § 1.114 (if the request for

continued examination under § 1.114 is not matched with the application before the application is processed into a patent).

Section 1.313(c) is amended to provide that an application may also be withdrawn from issue after payment of the issue fee on petition by the applicant for consideration of a request for continued examination in compliance with § 1.114. This language differs from the language of interim § 1.313(c)(2), but the change simply clarifies the requirements for an application to be withdrawn from issue under § 1.313(c)(2).

The Office cannot ensure that any petition under § 1.313(c) will be acted upon prior to the date of patent grant. *See Filing of Continuing Applications, Amendments, or Petitions after Payment of Issue Fee*, Notice, 1221 Off. Gaz. Pat. Office 14 (April 8, 1999). Since a request for continued examination under § 1.114 (unlike a CPA under § 1.53(d)) is not any type of new application filing, the Office cannot grant a petition to convert an untimely request for continued examination under § 1.114 to a continuing application under § 1.53(b). Therefore, applicants are strongly cautioned to file any desired request for continued examination under § 1.114 prior to payment of the issue fee. In addition, applicants considering filing a request for continued examination under § 1.114 after payment of the issue fee are strongly cautioned to call the Office of Petitions to determine whether sufficient time remains before the patent issue date to consider (and grant) a petition under § 1.313(c) and what steps are needed to ensure that a grantable petition under § 1.313(c) is before an appropriate official in the Office of Petitions in sufficient time to grant the petition before the patent is issued. Finally, applicants filing a request for continued examination under § 1.114 after allowance but prior to payment of the issue fee are cautioned against subsequently paying the issue fee because doing so may result in the prompt issuance of a patent.

Response to comments: The Office received fifteen written comments (from Intellectual Property Organizations, Law Firms, Patent Practitioners, and others) in response to the Interim Rule. Comments generally in support of a change are not discussed. The comments and the Office's responses to those comments (as well as the comments on the proposed change to § 1.103 in the Patent Business Goals Notice of Proposed Rulemaking) follow:

Comment 1: One comment suggested that simply applying the basic filing fee